

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICKY BORCEA and ALEXANDRU D. IONESCU

Appeal No. 95-4336
Application 08/057,898¹

ON BRIEF

Before CALVERT, FRANKFORT and ABRAMS, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 16, the only claim remaining in the application.

Claim 16 is drawn to an electromagnetic servovalve, and is reproduced in the Appendix to appellants' Supplemental

¹Application for patent filed May 7, 1993.

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Reply Brief.

The reference applied in the final rejection is:

Montelius (Sweden) 196,517 Jun. 01, 1965²

An additional reference of record,³ applied herein in a rejection pursuant to 37 CFR § 1.196(b) is:

Ichiyonagi (Japanese Kokai) 57-1807 Jan. 07, 1982⁴

Claim 16 stands finally rejected under 35 USC § 102(b) as anticipated by Montelius.⁵

²Our understanding of this reference is based upon a translation thereof (not including the claims) submitted by appellants at an interview with the examiner on April 20, 1994 (Paper No. 6).

³This reference was applied in Paper No. 17 (see footnote 5, *infra*), but does not appear to have been listed on a PTO-892 form in this application.

⁴Our understanding of this reference is based upon a translation of the disclosure relating to Fig. 1 thereof, prepared by the PTO on December 15, 1994. A copy of the translation was forwarded to appellants with Paper No. 17.

⁵In the final rejection (Paper No. 5), claim 16 was rejected under § 102(b) as anticipated by Montelius or by Japanese Kokai 58-166183, as well as under § 112, second paragraph. The examiner indicated in two Advisory Actions (Paper Nos. 8 and 11) that the § 112 rejection was overcome by amendments filed on May 23 and 31, 1994, respectively. In a Supplemental Examiner's Answer (Paper No. 17), the examiner rejected claim 16 on the new grounds of double patenting and anticipation by Ichiyonagi under § 102(b), but, following the filing of an amendment and a terminal disclaimer, he issued a second Supplemental Examiner's Answer (Paper No. 22), withdrawing all grounds of rejection except for the ground (anticipation by Montelius) now before us.

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First Rejection Under 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), claim 16 is rejected for failure to comply with the second paragraph of 35 USC § 112. The claim is indefinite, in that "said magnet means" in lines 8, 10,

11 and 13 to 15 has no antecedent basis. The antecedent of this term evidently was intended to be "a magnetic means" in line 6, but "magnetic" and "magnet", besides being different terms, are not of the same scope.

The Final Rejection

Where, as here, a claim is indefinite, it should not be rejected as unpatentable over prior art if it is necessary to engage in considerable speculation as to the meaning of terms in the claim and assumptions as to its scope. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). However, in the present case we will, in the interest of avoiding possible piecemeal appellate review, interpret the claim in accordance with appellants' perceived intent in order to determine the applicability of the prior art thereto.

In their brief (page 7) and reply brief (pages 2 to 4),

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appellants consistently refer to a "magnet means" rather than to a "magnetic means". It therefore appears that they intended "a magnetic means" in line 6 of claim 16 to be "a magnet means", and we will read the claim as if it had been so amended in considering its patentability under 35 USC § 102 and § 103.

Thus construed, we do not regard the "magnet means" recited in claim 16 as being a "means" within the provisions of the sixth paragraph of § 112. Merely because a named element of a claim is followed by the word "means" does not automatically make that element a "means-plus-function" element under § 112, sixth para-graph. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 530, 141 USPQ2d 1001, 1006 (Fed. Cir. 1996), cert. denied, 118 S.Ct. 56 (1997). That paragraph provides that an element in a claim "may be expressed as a means . . . for performing a specified function", but in the present case, no function whatsoever is recited as being performed by the "magnet means". We therefore construe "a

magnet means" as defining the same structure as "a magnet".

Given our construction of the claim language, it is evident that claim 16 is not anticipated by Montelius, because Montelius does not disclose structure meeting the claim limitations of a magnet "spaced from said circumscribing end wall of said coil housing" and a movable header cylinder core (42 of Montelius) "disposed about said magnet means [magnet] within the space defined between said circumscribing end wall of said coil housing and said magnet means [magnet]". Contrary to these limitations,

Montelius' magnet 35 is located outside the core 42, at the circumscribing end wall of housing 33, and a core 40 is located within core 42. While the recited magnet structure and Montelius' magnet structure may be functionally equivalent, as the examiner asserts on page 6 of the second supplemental answer (Paper No. 22), that is not sufficient, since to anticipate a claim, a reference must disclose expressly or inherently all of the limitations recited in the claim. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As noted above, Montelius does not

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disclose all of the limitations recited in claim 16 (as construed), and therefore does not anticipate.

The rejection under § 102(b) will not be sustained.

Second Rejection Under 37 CFR 1.196(b)

Pursuant to 37 CFR 1.96(b), claim 16 is rejected under 35 USC § 103 as unpatentable over Montelius in view of Ichiyanagi.

Montelius discloses all of the claimed structure except, as discussed above, magnet 35 is annular and positioned at the circumscribing end wall of housing 33, surrounding cylinder (core) 42, there being a core 40 within and coaxial with the cylinder 42.

Ichiyanagi discloses in Fig. 1, an electromagnetic servo-valve in which there is a magnet 5 positioned on the central axis of the housing 4 and valve body 3, the magnet being spaced from the circumscribing end wall of housing 4. A header 6 attached to valve body 3 includes a cylinder which carries coil 7 and is located in the space between the circumscribing wall and the magnet. In view of this

disclosure, we consider that it would have been obvious to one of ordinary skill in the art to utilize a centrally-located magnet in the electromagnetic actuator portion of the Montelius valve instead of the annular magnet arrangement disclosed by Montelius, this being simply the use of one known arrangement for the electromagnetic actuator of a spool valve in place of another.

In reaching our determination of obviousness, we have taken into account the (undated) declaration of applicant Nicky Borcea, submitted with the Amendment and Reply filed on May 23, 1994.⁶ According to the accompanying remarks, this declaration shows the commercial success of the claimed invention.

The declaration states, *inter alia*, that Robohand, Inc., of which Mr. Borcea is president, began manufacturing the claimed "voice coil" servovalve in 1993; that since January 1, 1994,

⁶The declaration was not considered with regard to the final rejection, since commercial success is not relevant to a rejection under 35 USC § 102. In re Paulsen, 30 F.3d 1475, 1482 n.11, 31 USPQ2d 1671, 1676 n. 11 (Fed. Cir. 1994).

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sales of the valve have increased 300%; and currently Robohand has a standing open purchase order to deliver 40 valves a month, which is indicative of commercial acceptance of the valve in view of the highly competitive nature of the marketplace for servo-valves. We do not regard this evidence as sufficient to rebut the *prima facie* case of obviousness made by the combination of Montelius and Ichiyanagi. Sales figures are a "very weak showing of commercial success, if any", where, as here, there is "no indication of whether this represents a substantial quantity in the market". In re Huang, 100 F.3d 135, 137, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). Also, it must be shown that the sales were a direct result of the unique characteristics of the claimed invention as opposed to other commercial and economic factors, such as lower cost, advertising, and the like. In other words, applicant must show a nexus between the sales and the merits of the claimed invention. In re Huang, supra; In re Paulsen, 30 F.3d at 1482, 31 USPQ2d at 1676. Mr. Borcea's declaration does not contain such a showing.

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Conclusion

The examiner's decision to reject claim 16 is reversed. Claim 16 is rejected pursuant to 37 CFR § 1.196(b) as being unpatentable (1) for failing to comply with 35 USC § 112, second paragraph, and (2) under 35 USC § 103.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard

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under § 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

Reversed
37 CFR 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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